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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,770	09/29/2003	Michael R. Klardie	14489.03	2472

7590 09/22/2004

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EXAMINER	
O CONNOR, CARY E	
ART UNIT	**PAPER NUMBER**
3732	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/673,770	KLARDIE ET AL	
	Examiner	Art Unit	
	Cary E. O'Connor	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *92903*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 2, 4 and 7 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 27 of prior U.S. Patent No. 6,626,671. This is a double patenting rejection. The method by which the roughened portions are formed cannot be given weight in an apparatus claim.

Claims 11, 13 and 14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 28 and 29 of prior U.S. Patent No. 6,626,671. This is a double patenting rejection. The method by which the roughened portions are formed cannot be given weight in an apparatus claim.

Claims 16 and 18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 28 and 29 of prior U.S. Patent No. 6,626,671. This is a double patenting rejection. The method by which the roughened portions are formed cannot be given weight in an apparatus claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of U.S. Patent No. 6,626,671 in view of Wagner et al (6,095,817). Wagner shows a dental implant with a roughened portion having an average surface roughness of about 75 to 300 microinches (column 4, lines 52-54) to promote bone attachment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the roughened portions of the patent claim with a surface roughness of about 6 to 9 microns, in view of Wagner, in order to promote bone attachment to the implant.

Claims 5, 6/2, 6/4, 6/5, 9, 10/7 and 10/9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of U.S. Patent No. 6,626,671 in view of Day (6,102,703). Day shows a dental implant which is self-tapping and has a hydroxyapatite coating. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the implant with a self-tapping formation and a hydroxyapatite coating, in view of Day, in order to

simplify the insertion of the implant in the jawbone and aid in osseointegration of the implant in the bone.

Claims 15/11, 15/13, 15/14, 19/16 and 19/18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 and 29 of U.S. Patent No. 6,626,671 in view of Day (6,102,703). Day shows a dental implant which is self-tapping and has a hydroxyapatite coating. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the implant with a self-tapping formation and a hydroxyapatite coating, in view of Day, in order to simplify the insertion of the implant in the jawbone and aid in osseointegration of the implant in the bone.

Claims 12 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 and 29 of U.S. Patent No. 6,626,671 in view of Wagner et al (6,095,817). Wagner shows a dental implant with a roughened portion having an average surface roughness of about 75 to 300 microinches (column 4, lines 52-54) to promote bone attachment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the roughened portions of the patent claim with a surface roughness of about 6 to 9 microns, in view of Wagner, in order to promote bone attachment to the implant.

Claims 6/3 and 10/8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of U.S. Patent No. 6,626,671 in view of Wagner et al (6,095,671), as applied to claims 3 and 8, and further in view of Day (6,102,703). Day shows a dental implant which is self-tapping

and has a hydroxyapatite coating. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the implant with a self-tapping formation and a hydroxyapatite coating, in view of Day, in order to simplify the insertion of the implant in the jawbone and aid in osseointegration of the implant in the bone.

Claims 15/12 and 19/17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 and 29 of U.S. Patent No. 6,626,671 in view of Wagner et al (6,095,671), as applied to claims 12 and 17, and further in view of Day (6,102,703). Day shows a dental implant which is self-tapping and has a hydroxyapatite coating. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the implant with a self-tapping formation and a hydroxyapatite coating, in view of Day, in order to simplify the insertion of the implant in the jawbone and aid in osseointegration of the implant in the bone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
September 17, 2004